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| 10/568,557 | 08/16/2006 | Adrian R. Temple-Brown | 562492006700 | 4364 |
| 20872 7590 02/20/2009 MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482 | | | | |
| EXAMINER | | | | |
| CHEN, XIAOLIANG | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,557

Applicant(s)

TEMPLE-BROWN, ADRIAN R.

Examiner

XIAOLIANG CHEN

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 10-14, 16-18, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10-14, 16-18, 20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Amendments

1. Acknowledgement is made of Amendment filed 01-26-09.

Response to Arguments

2. Applicant's arguments filed 01-26-09 have been fully considered but they are not persuasive.

A. Applicant argues that Kao does not disclose "the holder is further provided with a conductive layer on a surface for positioning adjacent the printed circuit board".

This argument is not persuasive because

Kao et al. disclose the holder is further provided with a conductive layer on a surface (solder leads or pads on the bottom, fig. 3) for positioning adjacent the printed circuitry board.

B. Applicant argues that if fixture cover 13 is viewed to correspond to the holder recited in claim 1, then the "surface for positioning adjacent the printed circuitry board" must be read to correspond to the under-surface of fixture cover 13 because it is the surface closest to the printed circuitry board as shown in FIG. 3 of the Kao reference. The under-surface of fixture cover 13 cannot be seen on FIG. 3 because FIG. 3 shows the top view of fixture cover 13 only.

This argument is not persuasive because

1) The examiner agrees that the "surface for positioning adjacent the printed circuitry board" must be read to correspond to the under-surface of fixture cover 13.

2) The examiner does not agree that the FIG. 3 shows the top view of fixture cover 13 only.

firstly, FIG. 3 is clearly a three dimensional drawing viewed from the top.

Secondly, without any doubt, any one in the art would see the eight solder leads or pads are on the bottom surface (for solder to the printed circuit board).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-8, 11-14, 16-18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao et al. (US20030227763) in view of Kocher (US6292004).

Re Claim 1, Kao et al. show and disclose

A holder for an electronic module (an apparatus for seating a SIM card [0008]) for connection to a printed circuit board (50, fig. 5) in an electronic equipment (a cell phone [0004]), the holder being arranged to receive the electronic module (fig. 6) and having a portion (42, fig. 6) provided with at least one hole therethrough (48, fig. 4A),

the holder is further provided with a conductive layer on a surface (solder leads or pads on the bottom, fig. 3) for positioning adjacent the printed circuitry board.

Kao et al. does not disclose

wherein at least one hole is arranged to provide access through the holder to the printed circuit board for testing;

Kocher teaches a device wherein

at least one hole (the test fixture has a plurality of test probe holes drilled through it [col. 2, line 10]) is arranged to provide access through the holder to the printed circuit board for testing (corresponds to the test points on the circuit board to be tested [col. 2, line 12]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the test probe holes as taught by

Kocher in the electronic device of Kao et al., in order to test the printed circuit board by the test probe probes. (Kocher, [Abstract])

Re Claim 2, Kao et al. show and disclose

The holder of claim 1 wherein the at least one hole is arranged to be covered by the electronic module when positioned in the holder (fig. 7).

Re Claim 3, Kao et al. show and disclose

The holder of claim 1 wherein the holder is provided with a plurality of holes (a plurality of test probe holes, see claim 1) therethrough.

Re Claim 4, Kao et al. show and disclose

The holder of claim 1 wherein the holder is arranged to be mounted on the printed circuitry board by one of A or B, wherein:

A comprises surface mount technology (the holder is mounted on the printed circuitry board by the surface mount leads or pads (fig. 3), and

B comprises plated through hole technology.

Re Claim 6, Kao et al. show and disclose

The holder of claim 1 wherein the electronic module comprises a subscriber identification module (SIM card [0002]).

Re Claim 7, Kao et al. show and disclose

The holder of claim 1 wherein the electronic equipment comprises wireless communication equipment (a cell phone [0004]).

Re Claim 8, Kao et al. show and disclose

The holder of claim 7 wherein the wireless communication equipment comprises a portable modem (SIM card [0002]).

Re Claim 11, Kao et al. show and disclose

A method of assembling a holder for an electronic module on a printed circuit board in an electronic equipment, the method comprising:

providing the printed circuit board (50, fig. 5);

providing a holder for the electronic module (an apparatus for seating a SIM card [0008]) for mounting to the printed circuit board (fig. 5), the holder being arranged to receive the electronic module (fig. 6) and having a portion (42, fig. 6) provided with at least one hole (48, fig. 4A) to provide access through the holder of the printed circuit board,

providing the holder with a conductive layer on a surface (solder leads or pads on the bottom, fig. 3) for positioning adjacent the printed circuit board; and

mounting the holder on the printed circuit board (fig. 5).

Kao et al. does not disclose

at least one hole to provide access through the holder of the printed circuit board for testing purposes;

Kocher teaches a device wherein

at least one hole (the test fixture has a plurality of test probe holes drilled through it [col. 2, line 10]) to provide access through the holder of the printed circuit board for testing purposes (corresponds to the test points on the circuit board to be tested [col. 2, line 12]);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the test probe holes as taught by Kocher in the electronic device of Kao et al., in order to test the printed circuit board by the test probe probes. (Kocher, [Abstract])

Re Claim 12, Kao et al. show and disclose

The method of claim 11 further comprising inserting the electronic module (insertion of the SIM card [0004]) in the holder such that the at least one hole is covered by the electronic module (fig. 7).

Re Claim 13, Kao et al. show and disclose

The method of claim 11 wherein the holder is provided with a plurality of holes (a plurality of test probe holes, see claim 11) therethrough.

Re Claim 14, Kao et al. show and disclose

The method of claim 11 wherein the step of mounting comprises mounting the electronic module on the printed circuit board by one of A or B, wherein:

A comprises surface mount technology (the holder is mounted on the printed circuitry board by the surface mount leads or pads (fig. 3), and

B comprises plated through hole technology.

Re Claim 16, Kao et al. show and disclose

The method of claim 11 wherein the electronic module comprises a subscriber identification module (SIM card [0002]).

Re Claim 17, Kao et al. show and disclose

The method of claim 11 wherein the electronic equipment comprises wireless communication equipment (a cell phone [0004]).

Re Claim 18, Kao et al. show and disclose

The method of claim 17 wherein the wireless communication equipment comprises a portable modem (SIM card [0002]).

Re Claim 22, Kao et al. show and disclose

An electronic circuit (23, fig. 6) having mounted thereon the holder of claim 1.

5. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao et al. in view of Kocher as applied to Claims 1-4, 6-8, 11-14, 16-18 and 22 above, and further in view of Kaneshige et al. (US5655917).

Re Claims 10 and 20, Kao et al. and Kocher disclose

According to claims 1 and 11 respectively,

Kao et al. and Kocher do not disclose

wherein the holder is of moulded plastics material.

Kaneshige et al. teaches a device wherein

the holder is of moulded plastics material. (The frame of the card holder is molded of plastic material [col. 2, line 8]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the moulded plastics material as taught by Kaneshige et al. for the card holder of Kao et al., in order to reduce the cost of the electronic device.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to XIAOLIANG CHEN whose telephone number is (571)272-9079. The examiner can normally be reached on 7:00-5:00 (EST), Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800, ext 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy C. Norris/
Primary Examiner, Art Unit 2841

Xiaoliang Chen
Examiner
Art Unit 2841